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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,116	08/26/2003	Paul Bacchi	40146/32:6	5500

3528 7590 11/17/2004

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EXAMINER

MARC, MCDIEUNEL

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/649,116		BACCHI ET AL.	
	Examiner		Art Unit	
	McDieunel Marc		3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-79 is/are allowed.
- 6) ☒ Claim(s) 80-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/26/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/24/03, 12/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-108 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 80-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,256,555 B1 and claims 1-11 of U.S. Patent No. 6,275,748 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application encompass the claims of the patents because they are broader.

Allowable Subject Matter

4. Claims 1-79 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fail to teach or fairly suggest with respect to claims 1 and 23, a specimen position sensing, edge-gripping device that is adapted for operative coupling to a mechanism and gripping a specimen by its peripheral edge, comprising a specimen contact mechanism that is actuatable between a specimen-releasing position and a specimen-securing position, the specimen-releasing position providing sufficient clearance for the specimen to rest on the distal pad specimen contacting surfaces and the specimen-securing position urging the peripheral edge of the specimen into the recess formed by the distal pad and distal backstop specimen contacting surfaces at each of the distal projections; with respect to claim 41, a method of removing from a

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specimen holder a specimen having a peripheral edge, comprising the step of actuating the specimen contact mechanism toward the specimen-securing position to grip the specimen by applying a motive force against the specimen to impart relative motion between it and the proximal and distal pad specimen contacting surfaces and thereby urge the peripheral edge near the distal end against the distal backstop specimen contacting surface; and moving the end effector out of the specimen holder to remove the specimen; with respect to claim 64, a method of removing from a specimen holder a specimen having a peripheral edge, the specimen holder constructed to hold multiple specimen in closely spaced apart slots including a lowermost slot, each of which slots configured to contain one of multiple specimens stacked generally parallel to one another comprising the step of moving the end effector out of the specimen holder to remove the specimen; and actuating the specimen contact mechanism toward the specimen-securing position to grip the specimen by applying a motive force against the specimen to impart relative motion between it and the proximal and distal pad specimen contacting surfaces and thereby urge the peripheral edge near the distal end against the distal backstop specimen contacting surface in combination with the other elements and features of the claimed invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to McDieunel Marc whose telephone number is (703) 305-4478. The examiner can normally be reached on 6:30-5:00 Mon-Thu.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (703) 305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



McDieunel Marc

Monday, November 14, 2004

MM/



THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 3800